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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/593,288	06/13/2000	Bernd Stein	860098.403C1	7248

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EXAMINER

PAK, YONG D

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 04/08/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/593,288

Applicant(s)

STEIN ET AL.

Examiner

Yong Pak

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 November 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 1 and 22.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 23-25.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The amendment filed November 4, 2002 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because: the proposed amendment raises new issues that would require further consideration and/or search.

Claims 1 and 22-26 are pending.

### ***Allowable Subject Matter***

Claims 1 and 22 are allowed.

### ***Response to Amendment***

Applicant's arguments are moot as drawn to rejection of claims 23-26 under 35 U.S.C. 112, 1<sup>st</sup> paragraph since the proposed amendment of claim 23 is not entered. The amendment raises new issues that would require further consideration. Even though applicants have amended claim 23 as a polypeptide capable of phosphorylating a substrate, the claim is drawn to a large variable genus of enzymes encompassing a broad class of enzymes able to phosphorylate any substrate. The disclosure is drawn to mitogen-activated protein kinase kinases. Therefore, the specification fails to describe any other representative species by any identifying characteristics or properties other than the "functionality" of phosphorylating any substrates. The examiner would also like to point out that the amendment does not contain cancellation of claim 26.

Applicant's arguments are moot as drawn to rejection of claims 23-26 under 35 U.S.C. 112, 1<sup>st</sup> paragraph, for lack of enablement since the proposed amendment of claim 23 is not entered. The amendment raises new issues that would require further consideration. Even though applicants have amended claim 23 as a polypeptide capable of phosphorylating a substrate, the claim is drawn to a large variable genus of enzymes encompassing a broad class of enzymes able to phosphorylate any substrate. The disclosure is drawn to mitogen-activated protein kinase kinases. Therefore, one of ordinary skill would require guidance in order to make any proteins capable of phosphorylating any substrates and how to use such proteins phosphorylating any substrates. Without such guidance, the experimentation left to those skilled in the art is undue. The examiner would also like to point out that the amendment does not contain cancellation of claim 26.

Applicant's arguments are moot as drawn to rejection of claims 25-26 under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, since the proposed amendment of claim 23 is not entered. The amendment raises new issues that would require further consideration, as discussed above. Further, the proposed amendment does not contain a cancellation of claim 26.

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***Double Patenting***

Claims 23-26 remains rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6,074,862. Applicants have requested that this rejection be held in abeyance until an allowable subject matter is indicated.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Pak whose telephone number is 703-308-9363. The examiner can normally be reached on Monday through Friday from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Ponnathapura Achutamurthy, can be reached on (703) 308-3804. The fax phone number for the organization where this application or proceeding is assigned is 703-746-3173.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Yong Pak  
Patent Examiner

August 30, 2001



YONG PAK  
PATENT EXAMINER  
UNIT 1652  
AUG 30 2001